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08/828,417	03/28/1997	HIROFUMI MIRASAKI	P9702-MG	4906

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LACKENBACH SIEGEL MARZULLO ARONSON  
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SCARSDALE, NY 10583

EXAMINER
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D'AGOSTINO, PAUL ANTHONY

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

08/828,417

**Applicant(s)**

MIRASAKI ET AL.

**Examiner**

Paul A. D'Agostino

**Art Unit**

3714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007 and 09 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

This responds to Applicant's Arguments/Remarks filed 05/09/2008 and 12/10/2007. Claims 45-46 and 50 have been amended, Claims 47-52 have been newly added and later amended. Claims 23-44 stand cancelled. Claims 45-52 are now pending in this application.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/9/2008 and 12/10/2007 have been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 45-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No support can be found in light of the specification for "partly or fully" generating a phrase and variations thereof. The specification discloses phrases (Fig. 4). When a phrase is executed it is executed. In no case is a partial or part of a phrase generated (See Fig. 4 wherein all phrases in the airg.box are phrases that are executed entirely and all at once).

4. Claims 45-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. No support can be reasonably found in light of the specification for making the execution of the commands conditional, specifically, "wherein **if** (emphasis added) a phrase selected from a superior phrase group includes a first command..." (Claim 45 (3 places) Page 3 Line 22, Page 4 Lines 1 and 4; also similarly 3 places in Claim 46). For every phrase in Fig. 4 there is a command. There is not a teaching suggested by Applicant whereby a first or second phrase does not have a command. It is reasonably assumed that a command is necessary in Applicant's claimed invention for there to be the operative layered configuration of Fig. 4 in the case of first and second commands. Even in the case of the "q" phrase being selected, "q" is the first command and it does not trigger any subsequent phrase selection processing.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 45-47 and 50 are rejected under 35 U.S.C. 102(b) as anticipated by JP 08-215433 to Toyama Shigeki.

Shigeki discloses a sound {speech} generation device, method and for a game machine (Title), comprising:

a storage unit for storing a plurality of phrase groups composed of a plurality of phrases respectively prepared for corresponding conditions; a phrase selection processing unit for monitoring the progress of a game and selecting a phrase from a phrase group corresponding to a predetermined condition when the predetermined condition is satisfied ([0009, and 0017-0020] of the detailed description discloses a voice data storage means which outputs play-by-play (PBP) broadcasting corresponding to a game expansion pattern (expression) and a selection mold junction data (selection data) may be outputted based on a read out command (phrase selection command. This way a player can enjoy PBP broadcasting of contents different each time.);

a sound output unit for converting data of the phrase selected by the phrase selection processing unit to a sound signal and outputting sound according to the sound signal ([0020 states that it is desirable to form from said selection mold junction data, so that the read-out command which reads the data of the contents of junction of arbitration at random may be outputted which means that different phrases are outputted based on the command and the selection data. [0021] discloses that the

computer program may choose 2 or more expressions meaning the same thing randomly and [0009] says that this is done in real time. [0023] discloses substitution data paragraphs [0024] and [0025] states two or more voices; also, [0056]);

said plurality of phrase groups have a hierarchical structure and including superior and subordinate phrase groups, each superior phrase group includes including, to partly or fully constitute generate a phrase, a first command for additionally selecting a phrase from a subordinate phrase, a second command for searching a subordinate phrase group and selecting a phrase from the subordinate phrase group, and a third command for playing no phrase, wherein if a phrase selected from a superior phrase includes a first command, the phrase selection processing continues to select an additional phrase from a subordinate phrase group designated by the first command; and if a phrase is selected from the superior phrase includes a second command, the phrase selection processing unit searches for a subordinate phrase group designated by the second command and selects a phrase from that subordinate phrase group; and wherein if the phrase selected by the phrase selection processing unit includes a third command, the sound output unit does not perform the sound output processing (As in the past Office Actions [0056-0071] have been presented to demonstrate a layered system and method, namely:

"[0056] The junction electronic speech circuit 50 of an example is constituted including the pattern distinction section 52, the speech synthesis section 54, the voice data storage section 56, and the junction change-over section 70."

"[0057] Beforehand, corresponding to two or more game expansion patterns, the predetermined voice data for play-by-play broadcasting writes in said voice data storage section 56, and it is memorized. Said voice data is the voice of the announcer of pro FESHONARU who performs the television actual condition, such as a Formula 1 race, and it is desirable to constitute as voice data which moreover had the same rhythm and intonation as actual play-by-play broadcasting."

"[0058] Moreover, in this example, the voice data for play-by-play broadcasting memorized in said voice data storage section 56 is constituted so that the voice data of the story which constitutes the story corresponding to a game expansion pattern, and has a data area for substitution voice in a part and two or more substitutable substitution voice data which constitutes the voice data of said data area for substitution voice may be included."

"[0059] And in order to memorize such voice data, the voice data storage section 56 of an example is constituted including the main data storage section 57 which memorizes two or more story voice data corresponding to a game expansion pattern, and the substitution data storage section 58 which memorizes said substitution voice data. "

"[0060] The example of the story voice data 700 memorized in the main data storage section 57 is shown in drawing 6, drawing 8, drawing 12 - drawing 17. It is square among drawing and the area [ surrounding ] 800 is a data area for substitution voice." This is the data box construction.

"[0061] As shown in drawing 8, a part of this story voice data 700 is constituted so that two or more selection mold junction data 710A of different contents of junction and 710B-- may be included. And the selection output of the one data is carried out at random from two or more of these junction data 710A and 710B--." One skilled in the art knows this to be an equivalent layered structure.

"[0062] Therefore, the same game expansion also becomes that from which the contents of the play-by-play broadcasting differed each time, and play-by-play broadcasting by which weariness does not come for a player and a gallery can be performed."

"[0067] Moreover, a game system is controlled by the game mode in which a game is actually performed after the count-down actuation for a start is completed next. The pattern distinction section 52 judges that the game system became this game mode based on the inputted data. And according to the flow chart shown in drawing 11, a fundamental game expansion pattern is judged and the voice data read-out command of play-by-play broadcasting of each routine shown in drawing 12 - drawing 17 based on the decision result is outputted (step 500)."

"[0068] Thus, the pattern distinction section 52 distinguishes game expansion of a game system, and outputs the read-out command of the voice data corresponding to game expansion to the speech synthesis section 54, in addition, as mentioned above, in the story voice data 700, the voice data area 800 for substitution is contained in the part. In such a case, the pattern distinction section 52 turns and outputs the substitution



voice data read-out command corresponding to this voice area 800 for substitution to the speech synthesis section 54."

"[0069] Furthermore, when said story voice data 700 contains two or more selection mold junction data 710A and 710B--, it is constituted so that the selection command to selection mold junction data may be outputted. Especially, in this example, the selection command to such selection mold junction data is performed at random each time, or it is set up so that the same data may be continued and it may not choose twice, and play-by-play broadcasting with a variation is performed."

"[0070] And based on the voice read-out command inputted by doing in this way, said speech synthesis section 54 reads the story voice data 700 and substitution voice data from the main data storage section 57 and the substitution data storage section 58 as voice data for play-by-play broadcasting, inserts substitution voice data in the data area 800 for substitution voice data of the story voice data 700, and compounds a sound signal. And it is constituted so that the compound sound signal may be outputted from a loudspeaker 62 through amplifier 60."

"[0071] The texture which could perform the expression of many in the number of data restricted by considering as the configuration which inserts substitution voice data in the substitution voice data area 800 of keynote voice data as especially mentioned above, and was doubled with the situation warm [sic] play-by-play broadcasting is attained. Thus, play-by-play broadcasting generated is play-by-play broadcasting based on the data of a real time vehicle, it stagnates as real announcer is carrying out, goes

on talking that there is nothing, and enables exciting play-by-play broadcasting to which it doubles with a situation and a tone is changed. "

Paragraphs [0105-113] disclose an example of different routines where different PBP broadcasting can occur including voice substitution area 800 selectable at random depending on the situation. Para graph [0128] says the invention is related to all games where PBP broadcasting is done. All of the above is related to a layered structure of having phrase pulled out of storage means randomly. Paragraphs [0080-0088] disclose an example of the embodiment with reference to multiple data storage areas for selection based on a action of the game, which in this case is starting the game. Paragraph [0090-0096] disclose that different voice data may be inserted at different junctions or points in the game.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claims 48-49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-215433 to Toyama Shigeki.

Shigeki discloses a system substantially equivalent to Applicant's claimed invention but is silent on the play-by-play being a different language of the voice being a different gender.

To provide various languages or genders of the announcers as is well known in viewing any major sporting event whereby the announcers are varied to meet the viewing needs of the consuming public and to comply with market forces to maintain viewership and ad revenues would only require routine skill in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the routine skill in the art to vary the play by play announcers and languages into the teachings of Shigeki in order to provide play-by-play

broadcasting differed each time, and play-by-play broadcasting by which weariness does not come for a player and a gallery can be performed." [0062].

### ***Response to Arguments***

11. Applicant's arguments filed 12/10/2007 have been fully considered but they are not persuasive. Applicant has amended the claims but Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Examiner has provided pertinent selections of the prior art and reasonably believes Applicant's claims as amended are anticipated despite the new matter rejections.

12. Applicant's arguments filed 5/9/2008 have been fully considered and they are persuasive. Thus, the rejection of claims under 35 U.S.C. § 112, first paragraph with respect to hierarchical structure is withdrawn.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/  
Examiner, Art Unit 3714